

### **REMARKS**

Applicants have carefully examined the Final Office Action mailed August 27, 2003, and the Advisory Action mailed February 20, 2004. This Amendment is being submitted along with a Request for Continued Examination (RCE). Claims 25, and 30-34 are pending. No new matter has been added. Applicants respectfully request favorable reconsideration in light of the above amendments and the following comments.

#### **Claim Rejections—35 U.S.C. § 102**

Remaining claims 25, 30, and 34 have been rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by Santoianni et al. (U.S. Patent No. 6,270,476). It is also somewhat apparent, but not clear, that the Examiner may have intended to reject claim 31 under 35 U.S.C. § 102(e) as being anticipated by Santoianni et al. Applicants respectfully traverse these rejections, to the extent that they are maintained.

The Examiner has indicated that Santoianni et al. disclose a guidewire system, as claimed. Applicants respectfully disagree, and assert that Santoianni et al. disclose a catheter for ablating tissue. There is a generally recognized and clear distinction between guidewire systems and ablation catheters by those of ordinary skill in the guidewire art, and others. As such, to one of ordinary skill in the art, Santoianni et al. do not disclose a guidewire system including a first wire and a second wire as claimed.

Furthermore, Santoianni et al. do not teach or suggest anything about a portion of a male thread that is adapted to be deformable when the male thread threadingly engages, is threaded into, or is threadingly engaged with a female thread. In independent claim 25, a portion of the male thread is adapted to deform when the male thread threadingly engages the female thread of the first wire. In independent claim 30, the second portion of the male thread is adapted to be more deformable than the first portion of the male thread when the male thread is threaded into the female thread. In independent claim 34, second portion of the male thread is adapted to deform when threadingly engaged with the female thread. Santoianni et al. do not teach anything about the deformability of a portion of a male thread.

In the Advisory Action, the Examiner states that item 77 of Santoianni et al. “can be characterized as alters the shape of by pressure or stress when item 77 threadingly engages the

thread of the first wire.” (Continuation sheet of the Advisory Action). However, a careful reading of Santoianni et al. does not indicate anything about item 77 (mating plug) being deformable and/or altering in shape when item 77 (mating plug) engages the thread of the first wire. Furthermore, while the mating plug 77 of Santoianni et al. may be threaded, nothing is taught or suggested about the thread including different portions, or including a portion of the thread that is adapted to deform when the male thread threadingly engages a female thread.

In the Final Office Action, the Examiner seems to indicate that this deformation of a portion of the male thread is somehow an inherent feature of Santoianni et al. Applicants respectfully disagree. Regarding inherency, the Board of Patent Appeals and Interferences has specified:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art. *Ex parte Levy*, 17 USPQ2d 1416, 1464, (Bd. Pat. App. & Inter. 1990); (See also, MPEP 2112).

Additionally, the Federal Circuit has stated:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed Cir. 1999); (See also, MPEP 2112).

The Federal Circuit has further stated:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed Cir. 1993); (See also, MPEP 2112).

Applicants respectfully submit that it is not inherent that a male/female threaded connection, for example the one generically disclosed in Santoianni et al, would necessarily include a male thread including a portion (of the thread) that is adapted to deform. Furthermore, the Examiner has provided no evidence that this missing descriptive matter (i.e., a male thread including a portion that is adapted to deform) is necessarily present in the threaded connection disclosed in Santoianni et al. For each of these reasons, Santoianni et al. do not disclose each

and every element of the claimed invention, and Applicants respectfully submit that claims 25 and 30-34 are in condition for allowance.

### **Claim Rejections—35 U.S.C. § 103**

Dependent claims 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Santoianni et al. Applicants respectfully traverse these rejections.

Dependent claims 32 and 33 depend from independent claim 30, and are therefore allowable over Santoianni et al. for the reasons discussed above regarding claim 30. These claims also include additional subject matter. Specifically, claim 32 recites that the second portion of the male thread includes a different thread pitch from the first portion of the male thread, and claim 33 recites that the second portion of the male thread includes a different thread size from the first portion of the male thread.

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. (See MPEP §2143 and §2143.03.) Nothing in Santoianni et al. teaches or suggests the structures claimed in claims 32 and 33 (or claims 25, 30, 31 or 34, for that matter).

Furthermore, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. (See MPEP §2143 and §2143.01.) Upon reading Santoianni et al., there is no suggestion or motivation to modify the generic threaded structures disclosed therein. There is no suggestion or motivation to provide a male thread that has two portions different from one another, much less suggest or motivate one to provide one portion such that is adapted to deform when threaded into the female thread. Further, Santoianni et al. certainly do not suggest or motivate one to provide a portion of the male thread that includes a different thread pitch or a different thread size from the other portion.

In the Final Office Action, the Examiner stated that “[i]t would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the thread of Santoianni et al. device with a different thread pitch and a different thread size ...” However, this does not meet the requirements of a *prima facie* case of obviousness. There is simply no teaching or suggestion of all the claim limitations in Santoianni et al., as required, and

Santoianni et al. do not provide the necessary suggestion or motivation to one of ordinary skill in the art to modify the structure disclosed in Santoianni et al.

Therefore, no *prima facie* case of obviousness has been made to render claims 32 and 33 (or for that matter, any of the pending claims) obvious in view of Santoianni et al.

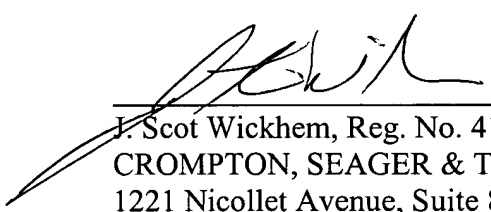
Reconsideration of the outstanding rejections is respectfully requested. Applicants submit that all pending claims are in condition for allowance. A Notice of Allowance in due course is respectfully requested. If a telephone conference may be of assistance, please contact the undersigned attorney at 612-677-9050.

Respectfully submitted,

BRIAN K. BALZUM ET AL.

By their Attorney,

Date: February 27, 2004



---

J. Scot Wickhem, Reg. No. 41,376  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612)359-9349